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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,241	07/19/2001	Rod Mancisidor	WHIS1100-2	8688
25094	7590	06/04/2004	EXAMINER	
GRAY, CARY, WARE & FREIDENRICH LLP 1221 SOUTH MOPAC EXPRESSWAY SUITE 400 AUSTIN, TX 78746-6875			BOOKER, KELVIN E	
		ART UNIT		PAPER NUMBER
		2121		
DATE MAILED: 06/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/909,241	MANCISIDOR ET AL.	
	Examiner	Art Unit	
	Kelvin E Booker	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-53 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: Detailed Office Action.

DETAILED ACTION

Response to Amendment

1. In Amendment "A", filed March 15, 2004 (see paper no. 11), **claims 1-20** have been canceled, and **claims 21-53** have been added. **Claims 21-53** are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 21-31** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. **Claim 21** is directed at a *method for providing a recommendation to a customer* without disclosing any computer implemented processing. Abstract ideas (see Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759) or the mere manipulation of abstract ideas (see Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58) are not patentable.

As disclosed, **independent claim 21** focuses on nonfunctional descriptive material, which is inclusive of the mere arrangement of data without engaging functionality when employed as a computer component.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 21-53** are rejected under 35 U.S.C. 102(e) as being anticipated by Coleman, U.S.

Patent Application Publication No. 2003/0061202.

As per claim 21, Coleman teaches of a method for providing a recommendation to a customer, comprising:

- A. determining a customer need for each of a set of traits (see page 6, paragraph [0056]: “Using fuzzy logic...limitations of available products”);
- B. rating a set of products, wherein rating each product further comprises rating each customer need against a value of the product using fuzzy logic, wherein the customer need and the value correspond to the same trait and the rating is relative to the customer need (see page 6, paragraphs [0054] to [0057]: “Fuzzy Logic...user requirements”); and
- C. recommending a product from the set of products (see page 6, paragraph [0057]: “For example...user requirements”).

As per claim 22, Coleman teaches of a method wherein rating each customer need against a value of the product using fuzzy logic employs a membership function (see abstract; and page 1, paragraph [0011]: using membership functionality respective of membership grades).

As per claim 23, Coleman teaches of a method wherein the membership function employs fuzzy sets (see page 6, paragraph [0054]: employing fuzzy logic in determining set membership).

As per claim 24, Coleman teaches of a method wherein rating each customer need against a value of the product using fuzzy logic comprises determining a customer satisfaction level corresponding to each trait (see page 9, paragraph [0077]: “The presentation...feature presentation, etc”).

As per claim 25, Coleman teaches of a method wherein rating each product against a value of the product using fuzzy logic comprises aggregating the customer satisfaction levels corresponding to the set of traits (see page 9, paragraph [0077]).

As per claim 26, Coleman teaches of a method wherein determining the customer need further comprises calculating the customer need based on a set of customer answers to a set of questions (see page 12, paragraph [0102]: “What has thus...fuzzy membership grade”).

As per claim 27, Coleman teaches of a method wherein determining the customer need comprises presenting the set of questions to the customer and receiving the set of answers from the customer (see page 10, paragraph [0084]: “When information...screen under 13”).

As per claim 28, Coleman teaches of a method wherein the set of questions are Internet access guidance engine questions (see page 10, paragraph [0084]).

As per claim 29, Coleman teaches of a method wherein the set of products are related to Internet access (see page 1, paragraph [0007] to paragraph [0011]: providing the user with a host of available services and products).

As per claim 30, Coleman teaches of a method wherein the set of traits include cost, ability to host a web site, reliability and bandwidth (see page 1, paragraph [0007] to paragraph [0011]).

As per claim 31, Coleman teaches of a method wherein recommending the product comprises providing an explanation of why the product is being recommended (see page 12, paragraph [0099]).

As per claims 32-42, the same limitations are subjected to in **claims 21-31**, respectively, therefore the same rejections apply (see claims 21-31 above).

As per claims 43-53, the same limitations are subjected to in **claims 21-31**, respectively, therefore the same rejections apply (see claims 21-31 above).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- A. Nakisa et al., U.S. Patent No. 6,741,975;
- B. Coleman, U.S. Patent Application Publication No. 2004/0024656;
- C. Mehrotra et al., U.S. Patent Application Publication No. 2003/0167222;
- D. Herz et al., U.S. Patent Application Publication No. 2001/0014868;
- E. Tuzhilin, U.S. Patent No. 6,236,978;
- F. Herz et al., U.S. Patent No. 6,088,722;
- G. Gupta et al., U.S. Patent No. 5,822,743; and
- H. Herz et al., U.S. Patent No. 5,758,257.

8. An inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Booker whose telephone number is (703) 308-4088. The examiner can normally be reached on Monday-Friday from 7:00 AM-5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight, can be reached on (703) 308-3179. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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Anthony Knight
Supervisory Patent Examiner
Group 3600

K.E.B.

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May 27, 2004